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Response under 37 C.F.R. 1.116
- Expedited Examining Procedure -
Examining Group 2622

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Tomas Roztocil, et al.

SYSTEM AND METHOD FOR
VISUAL REPRESENTATION OF
TABS IN A PRODUCTION
PRINTING WORKFLOW

Serial No. 09/803,166

Filed 09 March 2001

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Sir:

Group Art Unit: 2622

Examiner: Twyler M. Lamb

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Debra Nowacki
Debra Nowacki

June 30, 2005
Date

REQUEST FOR RECONSIDERATION

Applicants respectfully request reconsideration of the Final
Rejection dated April 25, 2005.

Paragraph 3 of the Office Action:

Claims 1-3, 15 and 35 are rejected as being obvious over Suzuki et al. in view of MacKay. The rejection is based on the Examiner's opinion that it would have been obvious to modify the system of Suzuki et al. in view of the teachings of MacKay. The rejection is respectfully traversed for the reasons set forth immediately below.

Suzuki et al. relates to a job scheduling system that assigns attributes to a job. The attributes are collation/uncollation, process start instruction wait, designation of exclusive processing, and designation of password input wait. Jobs are scheduled and processed by passing the jobs to a job execution section. Not surprisingly since Suzuki et al. has nothing to do with the insertion of ordered media into a document, the Examiner states that Suzuki et al.

“do not disclose the limitation of a page object representing a page attribute of one of at least one page, which being associated with a third visual representation on display and capable of being associated with first document object, a second user input device for creating page object, which operative to allow selection of page attribute, setting of a value of page attribute of one or more of at least one page in document to apply page attribute to wherein upon application, one or more of age objects are created and associated with each of one or more of at least one page and corresponding document object, wherein association of first, second and third visual representation results in association of respective objects and further wherein applied page attribute is visually represented on a visual representation of one or more of at least one page.”

The Examiner notes that the suggested combination with MacKay would provide the features missing from Suzuki et al., and concludes that such combination would have been obvious. This conclusion is respectfully traversed.

There is no motivation within the prior art for the combination:

In his Response to Arguments, the Examiner fails to respond to Applicant's earlier arguments that obviousness can only be established by combining references where there is some teaching, suggestion, or motivation to do so in the references themselves or in generally available knowledge. After failing to acknowledge this requirement to show motivation, the Examiner suggests that motivation to combine the teaching of MacKay with that of Suzuki et al. exists since “By doing so, the system would [be] enhance[d] by providing better editing tools in printing workflow environment to end users.”

The Examiner is proposing that the motivation to combine MacKay with that of Suzuki et al. is present because the combination would enhance the operation and thereby provide a better result than would the primary reference alone. In effect, what the Examiner suggests is that the motivation for the modification is that it is an improvement over the primary reference. Expanding on that reasoning would lead one to the conclusion that the only combinations of prior art references that are non-obvious are those that would result in a device that does not work better than the primary reference alone.

Applicant proposes that the test for motivation is not merely that the combination would be an improvement over the primary reference, but that there was some explicit teaching or suggestion in art to motivate one of ordinary skill to combine elements so as to create same invention. This is supported by *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941 (Fed. Cir. 1992), which requires that

the Examiner identify where the prior art provides a motivating suggestion for the modification. The Court held "Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so ... *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ.2d 1596, 1598-99 (Fed. Cir. 1988). "[at 1943]. "The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound. "[at 1944].

Moreover, the Courts have uniformly held that a modification is not obvious unless the prior art suggests the desirability for the modification, as for example, in the decision in *In re Fritch*, 922 F.2d 1260, 23 USPQ.2d 1780 (Fed. Cir. 1992), where the Court held:

"The mere fact that prior art may be modified to reflect features of claimed invention does not make modification, and hence claimed invention, obvious unless desirability of such modification is **suggested by prior art** ... "[at 1780] (Emphasis added)

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious **unless the prior art suggested the desirability of the modification**. *In re Gordon*, 733 F.2d at 902, 221 USPQ at 1127. "[at 1783] (Emphasis added)

Applicant believes that the motivational test applied by the Examiner is incorrect, and that there is no motivation to one skilled in the art to modify the subject matter of Suzuki et al. in view of the teachings of MacKay. In the present application, it is not the prior art that suggests that combining MacKay with Suzuki et al. so that "the system would [be] enhance[d] by providing better editing tools in printing workflow environment to end users" as suggested by the Examiner; but rather it is the specification of the present application that provides such teaching. "It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, Supra.

The references in combination do not disclose the claimed invention:

Assuming arguendo that the MacKay and Suzuki et al. might be capable of combination, there is at least one limitation in the claimed invention that is not disclosed by the references individually or in combination.

According to the Examiner, "*do not disclose the limitation of a page object representing a page attribute of one of at least one page, which being*

associated with a third visual representation on display and capable of being associated with first document object, a second user input device for creating page object, which operative to allow selection of page attribute, setting of a value of page attribute of one or more of at least one page in document to apply page attribute to wherein upon application, one or more of age objects are created and associated with each of one or more of at least one page and corresponding document object, wherein association of first, second and third visual representation results in association of respective objects and further wherein applied page attribute is visually represented on a visual representation of one or more of at least one page.” The Examiner suggested that MacKay would provide the features missing from Suzuki et al. if the references were combined. With regard to Claims 1-3, however, MacKay also fails to disclose a page object representing an ordered media attribute, a first user input device for selectively associating visual representations of document and page objects, and a second user input device for creating page objects which is operative to allow selection of ordered media attributes, setting values of the ordered media attributes and selection of one or more pages to apply to the ordered media attributes. As regards Claims 15 and 35, the references taken singularly or in combination, fail to disclose or suggest a visual representation of ordered media pages to be inserted in a document on a display according to ordered media attributes.

Paragraph 4 of the Office Action:

Claims 4-6, 16, and 36 are rejected as being obvious over Suzuki et al. in view of MacKay and further in view of Quinion. The rejection is respectfully traversed for the reasons set forth above with respect to the rejection of Claims 1-3, 15 and 35, and further because the Examiner has not made any reference to an explicit teaching or suggestion in the art to motivate one of ordinary skill to combine the features of Quinion with the other references.

The Examiner is proposing that the motivation to combine Quinion with Suzuki et al. and MacKay is that *“by doing so, the system would [be] enhance[d] by allowing user apprised of which printing selections are available for a print job task.”* Again, the Examiner suggests that the motivation for the modification is that it is an improvement over the other reference.

Also again, Applicant notes that the test for motivation is not merely that the combination would be an improvement over the primary reference, but that there was some explicit teaching or suggestion in art to motivate one of ordinary skill to combine elements so as to create same invention.

When addressing Claim 5, the Examiner suggests that it would have been obvious to use the drag-and-drop functionality of Quinion in the combination of Suzuki et al. and MacKay because *"the system would [be] enhance[d] by allowing [a] user to drag from one object and drop its at any desired location for printing job task."* Again, the Examiner mistakenly finds motivation in the fact that the present invention offers an advantage over the prior art. Applicant believes that the motivational test applied by the Examiner is incorrect, and that there is no motivation to one skilled in the art to modify the subject matter of Suzuki et al. and MacKay in view of the teachings of Quinion.

Paragraph 5 of the Office Action:

Claims 6-14, 17-34, and 37-54 are rejected as being obvious over Suzuki et al. in view of MacKay and further in view of Sklut et al. The rejection is respectfully traversed for the reasons set forth above with respect to the rejection of Claims 1-3, 15 and 35, and further because the Examiner has not made any reference to an explicit teaching or suggestion in the art to motivate one of ordinary skill to combine the features of Sklut et al. with the other references.

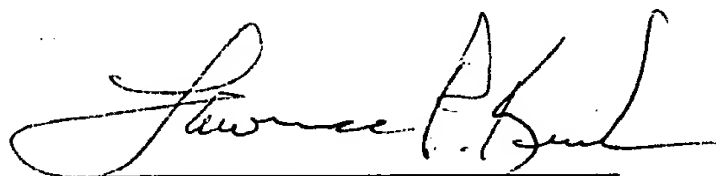
Regarding Claims 6-14, 18-34 and 38-54, the Examiner is proposing that the motivation to combine Sklut et al. with Suzuki et al. and MacKay is because *"the system would [be] enhance[d] by providing better selection of attribute characteristics to end users."* Regarding Claims 17 and 37, the Examiner is proposing that the motivation to combine Sklut et al. with Suzuki et al. and MacKay is because *"the system would [be] enhance[d] by providing more variety printer formats to end user in order of controlling printing task."* Again, the Examiner suggests is that the motivation for the modification is that it is an improvement over the other reference.

The test for motivation is not merely that the combination would be an improvement over the primary reference, but that there was some explicit teaching or suggestion in art to motivate one of ordinary skill to combine elements so as to create same invention. The motivational test applied by the Examiner is incorrect, and that there is no motivation to one skilled in the art to

modify the subject matter of Suzuki et al. and MacKay in view of the teachings of Sklut et al.

In view of the foregoing, it is believed none of the references, taken singly or in combination, disclose the claimed invention. Accordingly, this application is believed to be in condition for allowance, the notice of which is respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Lawrence P. Kessler", written over a horizontal line.

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.